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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,163	08/04/2005	Arthur J. Roth	02618.4006X0	9165
5514 7590 07/02/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
COLE, ELIZABETH M				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,163

Applicant(s)

ROTH ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-84.88 and 120-125 is/are pending in the application.
- 4a) Of the above claim(s) 125 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-84.88 and 120-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Newly submitted claim 125 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: This application contains claims directed to the following patentably distinct species: Species 1, claims 68-84, 88, 120-124, drawn to a method wherein the web material is formed into a sleeve like configuration and then filled with a matrix resin and species 2, claim 125 which is drawn to a method wherein the matrix resin is deposited and then the sleeve like configuration is formed. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

2. There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claim 125 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 68-84, 88, 120-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoi et al, U.S. Patent NO. 6,635,343 in view of Stevens, U.S. Patent No. 5,474,721. Motoi et al discloses a method of making a composite material comprising providing a fibrous layer, applying a thermosetting resin precursor to the fibrous layer, forming the layer into a tube, (which corresponds to the claimed sleeve-like configuration), injecting a fluid matrix resin into the sleeve and holding the components so that they are held in place and subjected to heating and cooling in order to foam and cure the components. See col. 27, line 39 – col. 29, line 24, as well as figure 12. Motoi teaches that suitable resins for the thermosetting resin precursor include polyurethanes, phenolic resins, polyester, epoxy resins, urea resins, and melamine resins. See col. 15, lines 31-38. Urea melamine and melamine formaldehyde resins are not specifically disclosed by Motoi, however, since Motoi teaches urea and melamine resins broadly, the person of ordinary skill would have been able to select particular known types of these resins for use, in view of the art

recognized suitability. Motoi teaches that suitable thermoplastic resins include polystyrene resins. See col. 11, lines 21-31. Motoi teaches that composite may further comprise various fillers including vitreous materials such as ground glass, carbonaceous materials, plastics and rubbers. See col. 6, lines 31-49. With regard to the particular amounts of filler used, since the filler is used to reinforce and also to either increase or decrease the weight of the composite, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the particular amounts through the process of routine experimentation which produced the desired weight, strength, etc. Suitable fibrous materials for use in the invention of Motoi include glass and polyester fibers. See col. 18, lines 38-50. While Motoi teaches the general process as set forth above, Motoi does not specifically teach providing a layer of porous web material and a layer of parallel strands as the sleeve forming material, wherein the porous material is on the outside of the sleeve in a single embodiment. However, Motoi teaches that the outer layers of the composite material can comprise one or more layers of fibrous material such as parallel fibers, unidirectional fibers, bidirectional fibers and sewn mats. See col. 12, lines 14-27. Motoi further teaches additional reinforcing layers of paper can be added to the structure. See col. 18, lines 37-50. Therefore, the person of ordinary skill would have recognized that Motoi teaches the claimed elements and teaches that the elements can be combined by the process as set forth above at col. 27-29. Motoi teaches the outer sleeve comprising the parallel fibers, the resin impregnation, the shape stabilization, and curing of the resin precursor. While Motoi does not teach adding the outer paper layer or the additional

fibrous layers to the embodiment set forth at cols. 27-29, since Motoi teaches that such additional layers can be added to the composite material in order to further strengthen the composite material, one of ordinary skill in the art would have been able to select additional layers, such as the claimed porous web material layer, in view of the teaching of Motoi that such layers can be added to the composite material. With regard to the newly added limitation that the thermosetting resin precursor mixture is non-foaming, it is noted that . Motoi prefers a foamable resin to form the outer fiber reinforced layer and while the claims of Motoi are not limited to foamable resins, Motoi's examples all employ a foamable resin. Stevens teaches that it is known in the art to employ a non foamable thermosetting resin to form the outer covering of a tube or sleeve-like configuration having a foam core. See drawings as well as col. 2, line 1 - col. 3, line 20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a non foamable thermosetting resin precursor instead of a foamable thermosetting resin precursor as taught by Stevens, in order to form the composite material of Motoi. One of ordinary skill in the art would have been able to select the use of either foamable or non foamable resins depending on the final intended use of the product, in view of the fact that both types of thermosetting resins were known in the art as useful for forming such composite shaped materials.

3. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection. With regard to the parent application, it is noted that the instant claims are not commensurate in scope with the allowed claims, the issues

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involved are not the same, and a different art rejection was employed in the parent application.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

The examiner's supervisor Rena Dye may be reached at (571) 272-3186.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

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